

## **REMARKS**

### **Overview**

Claims 1-27 were previously pending in this application. Claims 2, 3, 5, 9 and 20-24 were withdrawn from consideration by the Examiner. Claims 1, 4, 6-8, 10, 11, 17-19, and 25-27 were rejected. Claims 12-14 were objected to but found allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. The subject matter of claim 10 has been amended into independent claims 1, 17 and 19. Claim 10 depended from claim 7 and claim 7 depended from claim 1. Therefore, claims 7 and 10 have been cancelled. Various other pending claims have been amended as described below.

The present response is an earnest effort to place all claims in proper form for immediate allowance. Applicant believes that no new matter has been added.

### **Objections to the Drawings**

The drawings were objected to by the Examiner and new corrected drawings in compliance with 37 C.F.R. § 1.121(b) were required.

The Examiner noted that reference character "10" has been used to designate both direction (page 7, line 6) and planer (page 11, line 8). Applicant notes that a typographical error on page 11, line 8 has been corrected changing "planer 10" to "planer 110". This can be seen in Figure 1 which shows the direction as 10 and Figure 8 which shows the planer as 110. Therefore, no new matter has been added. Applicant believes this change in the Specification overcomes the drawing objection.

The drawings were additionally objected to under 37 C.F.R. § 1.83(a) for not showing a "motor" as required in claim 4. However, Applicant notes that the Specification, page 7, lines

15-17 state that " The cylinder rotation is driven by drive means 28 mounted in the body housing with the drive means typically comprising an electric motor connected to the cylinder to drive the same to rotate in a conventional way." Therefore, the motor as required in the claims, is disclosed in the Specification and indicated as number 28, which can be seen on Figures 1 and 6. Therefore, this objection is defective and should be withdrawn. Withdrawal of this objection is respectfully requested.

The Examiner objected to the drawings under 37 C.F.R. § 1.84(p)(5) because the Examiner noted that reference characters 39 and 41 were not mentioned in the description. Applicant indicates to the Examiner that on page 8, lines 18-20 this Specification discloses that a "flap [46] can be *pivoted* 39 by the user gripping the externally positioned *paddle* 41, to close off one of the channels and passages . . . ". Therefore, the reference characters 39, meaning pivoted, and 41, a paddle, both shown in Figure 6, are mentioned in the description. Therefore, this objection is defective and should be withdrawn. Withdrawal of this objection is respectfully requested.

### **Objections to the Specification**

The Examiner has objected to various wordings and typographical errors in the Specification. The changes requested by the Examiner on page 4 of the Office Action dated August 25, 2005 have been amended into the Specification (see pages 2-3 of this amendment) and claim 12, where the word "pass age" should have been combined as "passage". Entry of the changes to the Specification and claim 12 as requested by the Examiner is respectfully requested.

### **Objections to Multiple Dependent Claims**

The Examiner objected to claims 15, 16 and 25-27 under 37 C.F.R. § 1.75(c) as being improper form because multiple dependent claims may not serve as a bases for another multiple dependent claim. Claims 15 and 16 have been amended to no longer be multiple dependent claims and now only depend from a single claim. Claims 25-27 have been amended and remain as multiple dependent claims, however, these claims do not depend from other multiple dependent claims. In other words, claims 25-27 only depend from independent claims 1, 17 and 19. Therefore, claims 15 and 16 and 25-27 have been amended to overcome the rejection under 37 C.F.R. § 1.75(c) and are now in proper form for allowance. A Notice of Allowance of these claims is respectfully requested.

### **Claims Rejections Under 35 U.S.C. § 112**

Claims 1, 4, 6-8, 10-14, 17 and 19 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner noted that claims 1, 17 and 19, the word "means" was preceded by the words "drive" and in claims 11 and 14, the word "means" was preceded by the words "user selection". It was unclear to the Examiner what was meant by these.

With regard to claims 1, 17 and 19, the words "drive means" has been replaced by the word "motor". The motor 28 is described on page 7, lines 15-17 and shown on Figures 1 and 6. Page 7, line 15 describes the motor 28 as a "drive means 28 mounted in the body housing with the drive means typically comprising an electric motor connected to the cylinder to drive the same." Therefore, changing the wording from drive means to motor is a change for clarity sake and is not meant to be limiting in any way. In addition, given

the fact that the motor is described in the specification and shown in the drawings, no new matter has been added.

With respect to claims 11 and 14, the terms "user selection means" has been changed to "a user selectable flap". The flap 46 is shown in Figure 6 and described on page 8, lines 17-22 which state "a flap 46 and the selection means is mounted with regard to the channels at location 45 so that the flap can be pivoted 39 by the user gripping the externally positioned panel 41, to close off one of the channels and passages . . . .". Therefore, changing the wording from user selection means to a user selectable flap is disclosed in the application and as a result, no new matter has been added. This change is for clarity sake and is not meant to be limiting. It is submitted Applicant overcomes these means plus function rejections. A Notice of Allowance for the applicable claims is respectfully requested.

The Examiner rejected claims 4, 6, 7 and 8 for not having proper antecedent basis. The Examiner noted that claim 4 did not have antecedent basis for "the motor". The term "motor" has been added to claim 1 as described above and therefore provides proper antecedent basis for claim 4.

The Examiner noted that claim 6 did not have proper antecedent basis for the term "the workpiece". The term "the workpiece" has been added to claim 1 to provide proper antecedent basis for claim 6. The Examiner stated that claim 6 also had improper antecedent basis for the term "the stream". Claim 6 has been amended to now read "a stream" rather than "the stream". Thus, proper antecedent basis is supplied for claim 6. Additionally, claim 6 has been amended to now read "a high speed" rather than "the high speed". Therefore, claim 6 has proper antecedent basis for these terms and should overcome the rejections.

The Examiner stated that the term "the housing" did not have proper antecedent basis in claim 7. However, claim 1, from which claim 7 depends, has the terms "mounted within a housing". Therefore, proper antecedent basis is supplied. However, claim 7 has been cancelled and the relevant matter has been amended into amended claim 1. Therefore, this rejection is moot.

The term "the draft" has been rejected in claim 8 for not having proper antecedent basis. Claim 8 has been amended to now read "a draft", as suggested by the Examiner. Therefore, claim 8 has proper antecedent basis.

The Examiner notes that with regard to claims 6-8 the terms "blade cylinder" and "cylinder" are used interchangeably. Claim 6 has been amended to correspond with claim 8 to read only "cylinder". Therefore, it should be clear to the Examiner that what is required by the amended claim limitation. Thus, this rejection has been overcome.

#### **Claim Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 1, 4 and 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Casal, Patent No. 5,024,000. Additionally, claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Casal in view Hild, Patent No. 5,383,275. Furthermore, claims 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Casal in view Hu, Patent No. 6,367,523. Independent claims 1, 17 and 19 have been amended and are believed to overcome all of these claim rejections.

Applicant submits that the Examiner is incorrect in objecting to a claim which would comprise the subject matter of claims 1, 7 and 10. The distinction between the wording of claim 10 and that of claim 12, which the Examiner indicated as allowable, is that claim 10 requires

only one channel to lead from the blade cylinder to two passages, whereas claim 12 requires two channels to pass from the blade cylinder to the respective passages. The Examiner suggested that the subject matter of claim 10 is disclosed by a combination of Casal and Hild. While Hold shows two discharge openings to either side of the housing, the discharge openings which are shown in Hild are not to the rear of the cylinder or the housing. Although Hild does not specifically state which is the front or rear of the tool, the position of the handle 5, the switch 6, which is conventionally operated by the index finger when grasping the handle support indicates that it is clear that the front of the tool is to the right in the elevation drawing of Figure 1 of Hild. In addition, the beveling on the cutting blade shown in the planar head 13 show that the blades travel in a counter clockwise direction as shown in Figure 1. This further indicates the front of the tool is to the right as shown in Figure 1. Thus, because the motor is positioned at the rear of the housing, the airflow which is generated passes from the fan mounted on the motor to the cylinder and then to the exits which are positioned towards the front of the housing and in front of the cylinder. Thus, the airflow and chips and debris is going in the opposite direction to that of the present invention. It is therefore incorrect for the Examiner to combine the teaching of Hild with Casal, as Casal shows a single exit and Hild shows two exits to the front of the cylinder. Because the motor in the present invention is located above the cylinder in the area behind the cylinder is available for the dust extraction channel along which the chip discharge passages. In addition, it would not have been obvious in light of Hild to discharge the debris to the rear because this would require the airflow carrying the debris to do a 180° turn, thus severely reducing effectiveness and efficiency of removing the debris and possibly causing the channel to clog. As a result, the Applicant believes that amended claims 1, 17 and 19 are not disclosed or suggested in any combination of the cited references.

Therefore, the relevant parts of claim 7, of which claim 10 depended, and claim 10 have been amended into amended independent claims 1, 17 and 19. It is submitted that amended claims 1, 17 and 19 are allowable. A Notice of Allowance of claims 1, 17 and 19 and those claims depending from them is respectfully requested.

## **Conclusion**

Independent claims 1, 17 and 19 have been amended to require allowable limitations of claims 7 and 10. Therefore, these independent claims are submitted as being allowable. In addition, various other claim objection and rejections have been remedied in this amendment and response. Furthermore, the specification and drawing objections have also been corrected as required by the Examiner. As a result, all claims currently pending are believed to be in proper form for immediate allowance. A Notice of Allowance of all pending claims is respectfully requested.

This amendment and response is an earnest attempt to put all claims in proper form for immediate allowance. If the Examiner does not believe that all claims are in form for immediate allowance, the Examiner is respectfully requested to contact Applicant's attorney at the below identified contact information to resolve any outstanding issues.

Please consider this a three-month extension of time from November 25, 2005 to February 25, 2006. Please charge Deposit Account No. 26-0084 in the amount of \$510.00 for this extension. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bart A. Fisher". The signature is stylized with a large, looped initial "B" and a trailing flourish.

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